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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,894	07/11/2003	Phillip J. Bouic	58670US004	4040

32692 7590 01/12/2007
3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER	
VO, HAI	
ART UNIT	**PAPER NUMBER**
1771	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/617,894	BOUIC ET AL.	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-65* is/are pending in the application.

4a) Of the above claim(s) *1-22, 27-43, and 45-64* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-26,44 and 65* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The claim objections have been withdrawn in view of the present amendment.

2. The double patenting rejections are maintained.

3. All of the art rejections are maintained.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 23-26, 44 and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,797,361 substantially as set forth in the 06/07/2006 Office Action.

6. Claims 23-26, 44 and 65 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No.10/617,893 substantially as set forth in the 06/07/2006 Office Action.

   The obviousness-type double patenting will not be withdrawn until the submission of the terminal disclaimer.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 23, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Bambara et al (US 5,350,544) substantially as set forth in the 06/07/2006 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that Bambara does mot teach or suggest an elongate foam polymer strip used as a masking material. It is reminded that a recitation with respect to the manner in which a claimed polymer article is intended to be employed does not differentiate the claimed polymer article from a prior art popyethylene foam product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Additionally, mere recitation of "used as a masking material" impacts no definite structure to the claimed polymer article and is therefore found inadequate to convey structure in any patentable sense. Accordingly, the art rejections are sustained.

9. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/46056 substantially as set forth in the 06/07/2006 Office

Action. The art rejections have been maintained for the following reasons. Applicants argue that nowhere does WO '056 disclose or teach a polymeric article including "a predetermined surface pattern in at least a portion of the sheet, the surface pattern including at least a first area that is partially compressed to define at least a part of the surface pattern and at least a second area that is compressed either more or less than the first area to define the predetermined surface pattern". The examiner respectfully disagrees. WO'056 teaches a foam strip for masking a gap between two parts of the vehicle having a surface pattern formed by applying pressure to the surface of the foam strip as shown in figure 2A. The foam strip includes an elongate strip 8 and a removable edge portion 10 which have different dimensions. The elongate strip portion reads on Applicants' first area and the removable edge portion corresponding to Applicants' second area. Accordingly, the art rejections are sustained.

10. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Bouic (US 6,797,361) substantially as set forth in the 06/07/2006 Office Action. Similarly, the art rejections over Bouic have been maintained. Bouic teaches a foam strip for masking a gap between two parts of the vehicle including an array of longitudinally extending parallel foam cords 5 joined by a cold weld seams 4. The foam cord and the seam read on Applicants' first and second portions of the surface pattern. Accordingly, the art rejections are sustained.

11. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Barrows et al (US 5,547,725). The art rejections have been maintained for the following reasons. Applicants argue that Barrows does not teach the claimed invention. The examiner respectfully disagrees. Barrows teaches a foam article suitable as a masking tape comprising a plurality of circular strips joined together by a joinder line as shown in figure 5. The circular strip and joinder read on Applicants' first and second portions of the surface pattern respectively. Accordingly, the art rejections are sustained.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 795 356 substantially as set forth in the 06/07/2006 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that EP'356 does not teach or suggest the claimed invention. The examiner respectfully disagrees. EP'356 teaches a masking strip for temporarily masking automotive body gaps in paint-spraying operations. The masking strip is made from an open celled polyurethane foam having a density from 20 to 30 kg/m3 [0002] and [0020]. The

masking strip has two portions 12 and 11 with different thickness as shown in figure 1. Each portion would read on Applicants' first area and second area. The art rejections over EP '356 are sustained.

Applicants further state that there is a misunderstanding as to what constitutes a "surface pattern". The statement is not commensurate in scope with the claims. Nothing is specific about the special features as shown in figures 8-14 as argued by Applicants. What the claims require are a "surface pattern" having a first area and second area having different dimensions. Therefore, the claimed subject matter does not exclude the polymer articles as described in the cited references.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hai Vo

HV

HAI VO
PRIMARY EXAMINER